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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|-------------|----------------------|---------------------|------------------|
| 10/606,011 | 06/24/2003 | Jay L. Gainsboro | 18279-08041 | 5720 |
| 758 | 7590 | 09/29/2006 | EXAMINER | |
| FENWICK & WEST LLP SILICON VALLEY CENTER 801 CALIFORNIA STREET MOUNTAIN VIEW, CA 94041 | | | GAUTHIER, GERALD | |
| | | | ART UNIT | PAPER NUMBER |
| | | | 2614 | |

DATE MAILED: 09/29/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

| | | | |
|------------------------------|------------------------|---------------------|--|
| Office Action Summary | Application No. | Applicant(s) | |
| | 10/606,011 | GAINSBORO, JAY L. | |
| | Examiner | Art Unit | |
| | Gerald Gauthier | 2614 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) Responsive to communication(s) filed on 19 May 2006.

2a) This action is FINAL. 2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) Claim(s) 59-65 and 72-78 is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5) Claim(s) _____ is/are allowed.

6) Claim(s) 59-65 and 72-78 is/are rejected.

7) Claim(s) _____ is/are objected to.

8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) Notice of References Cited (PTO-892) 4) Interview Summary (PTO-413)
 2) Notice of Draftsperson's Patent Drawing Review (PTO-948) Paper No(s)/Mail Date. _____.
 3) Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
 Paper No(s)/Mail Date _____.

5) Notice of Informal Patent Application (PTO-152)
 6) Other: _____.

DETAILED ACTION

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

3. **Claim(s) 59-65** are rejected under 35 U.S.C. 103(a) as being unpatentable over Brown et al. (US 5,535,261) in view of Kitchin et al. (US 5,539,812) and further in view of Naylor (US 4,001,513).

Regarding **claim(s) 59 and 72**, Brown discloses a method for controlling institutional communications (FIG. 1 and column 1, lines 9-13), comprising:

recording a conversation on telephone connection between a regulated calling party and a called party, the regulated calling party residing in an institution (column 3, lines 36-49);

detecting tones arising during the telephone connection (column 3, lines 36-42).

Brown discloses starting the recording of the telephone conversation on a 3-way calling signal but fails to disclose preventing such call.

However, Kitchin teaches wherein the call-bridging tone set includes at least one of dial tones, busy signal tones, ring signal tones, dual tone multi-frequency tones, and special instruction tones (column 13, lines 37-48); and

executing call-bridging prevention instructions in response to an identified call-bridging attempt based upon comparing the tones to the predetermined call bridging tone set (column 13, lines 49-65).

Therefore, it would have been obvious to one of the ordinary skill in the art at the time the invention was made to modify the invention of Brown using the teaching of prevention of 3-way call as taught by Kitchin.

This modification of the invention enables the system to prevent 3-way call so that the system would control outgoing call of inmates.

Brown fails to disclose comparing the tones to a predetermined call-bridging tone set to identify an attempt to bridge the telephone connection.

However, Naylor teaches comparing the tones to a predetermined call-bridging tone set to identify an attempt to bridge the telephone connection between the regulated calling party and the call party to include a third party (column 5, line 65 to column 6, line 21).

Therefore, it would have been obvious to one of the ordinary skill in the art at the time the invention was made to modify the invention of Brown using the teaching of fraudulent call detection as taught by Naylor.

This modification of the invention enables the system to compare the tones to a predetermined call-bridging tone set to identify an attempt to bridge the telephone connection so that the system would control outgoing fraudulent calls.

Regarding **claim(s) 60 and 73**, Brown discloses a method, wherein executing the call-bridging prevention instructions comprises: terminating the telephone connection (column 8, lines 46-51).

Regarding **claim(s) 61 and 74**, Brown discloses a method, wherein executing the call-bridging prevention instructions comprises: inserting a warning message into the telephone connection (column 8, lines 60-62).

Regarding **claim(s) 62 and 75**, Brown discloses a method, wherein executing the call-bridging prevention instructions comprises: recording a telephone number of the third party (column 8, lines 62-67).

Regarding **claim(s) 63 and 76**, Brown discloses a method, wherein executing the call-bridging prevention instructions comprises: blocking further calls between the regulated calling party and the called party (column 8, lines 62-67).

Regarding **claim(s) 64 and 77**, Brown discloses a method, wherein executing the call-bridging prevention instructions comprises: comparing a telephone number of the third party against a list of authorized called parties (column 8, lines 46-51); and terminating the telephone connection unless the telephone number of the third party appears on the list of authorized called parties (column 8, lines 62-67).

Regarding **claim(s) 65 and 78**, Brown discloses a method, wherein executing the call-bridging prevention instructions comprises: recording a conversation on telephone connection between a regulated calling party and a called party, the regulated calling party residing in an institution (column 8, lines 46-51); detecting tones arising during the telephone connection (column 8, lines 46-51); comparing the tones to a predetermined call-bridging tone set to identify an attempt to bridge the telephone connection between the regulated calling party and the called party to include a third party, wherein the call-bridging tone set includes at least one of dial tones, busy signal tones, ring signal tones, dual tone multi-frequency tones, and special instruction tones (column 8, lines 46-51); and executing call-bridging prevention instructions in response to an identified call-bridging attempt based upon comparing the tones to the predetermined call bridging tone set (column 9, lines 15-32).

Response to Arguments

4. Applicant's arguments with respect to **claim(s) 59-65 and 72-78** have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gerald Gauthier whose telephone number is (571) 272-7539. The examiner can normally be reached on 8:00 AM to 4:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Fan Tsang can be reached on (571) 272-7547. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.


GERALD GAUTHIER
PATENT EXAMINER
GG
September 26, 2006

Gerald Gauthier
Examiner
Art Unit 2614